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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Dave Snowden

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07/28/2004

John E. Beck
Xerox Corporation
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EXAMINER

MILIA, MARK R

ART UNIT

PAPER NUMBER

2622

DATE MAILED: 07/28/2004

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/745,927

Applicant(s)

SNOWDON ET AL.

Examiner

Mark R. Milia

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "30" has been used to designate both a programmable document and a personal computer. Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "32" and "36" have both been used to designate a recording device. Reference characters "34" and "38" have both been used to designate a read/write device. Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by

the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Fig.4 (step50). Corrected drawing sheets, or amendment to the specification to add the reference character(s) in the description, are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities: On page 1, line 27 "It electronic copy exists, it may not accessible" should read "If electronic copy exists, it may not be accessible". Line 29, "It" should read "If". On page 6 line 21 "sell" should read "well". Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 7, 9, 10-13, and 15-17 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6585154 to Ostrover et al. Ostrover clearly teaches a programmable physical document including all the limitations recited in claims 1-3, 7, 9, 10-13, and 15-17.

Referring to claim 1, Ostrover teaches a programmable document comprising a physical document including at least one sheet of material and information recorded thereon (see column 4 lines 27-29 and 43-45), and a computer attached to the physical document, wherein the computer includes an input/output device, a processor and a memory storing the recorded information in digital form and metadata pertaining to the physical document (see column 3 lines 38-42 and 63-67, column 4 lines 1-13 and 46-67, and column 5 lines 1 and 15-20, reference states that the data may be in a standard file format in which the examples listed inherently have metadata).

Referring to claim 2, Ostrover teaches wherein the metadata comprises at least one of processing information, version information, user comments, copy information, transformation information, distribution information and index information (see column 4

Art Unit: 2622

lines 43-64, reference states that the data may be in a standard file format in which the examples listed inherently have metadata).

Referring to claim 3, Ostrover teaches wherein the computer is attached to the physical document by at least one of an adhesive, a removable adhesive, a magnetic material (see column 5 lines 2-9).

Referring to claim 7, Ostrover teaches a programmable document comprising a physical document including at least one sheet of material for receiving information recorded thereon (see column 4 lines 27-29 and 43-45), and a computer attached to the physical document, wherein the computer includes an input/output device, a processor and a memory for storing information pertaining to the physical document (see column 3 lines 38-42 and 63-67, column 4 lines 1-13 and 46-67, and column 5 lines 1 and 15-20), a recording device for recording information on a sheet of material (see column 5 lines 16-22 and 66-67 and column 6 lines 1-3), a device for attaching a computer to a physical document (see column 6 lines 16-22), and a reader for reading information from and writing information to the programmable document computer (see column 6 lines 46-60).

Referring to claim 9, Ostrover teaches wherein the recording device is selected from the group consisting of printer, copier, scanner and multi-function device (see column 6 lines 53-60).

Referring to claim 10, Ostrover teaches recording information on at least one sheet of material to generate a physical document (see column 5 lines 16-22 and 66-67 and column 6 lines 1-3), storing a digital copy of the recorded information and metadata

pertaining to the physical document in a computer, wherein the computer includes an input/output device, a processor and a memory (see column 3 lines 63-67, column 4 lines 1-10, and column 6 lines 53-60), associating the stored information with the physical document (see column 6 lines 16-22), and attaching the computer to the physical document (see column 5 lines 1-9).

Referring to claim 11, Ostrover teaches performing an activity pertaining to the physical document and storing a digital record of the performed activity in the computer (see columns 4-6, reference teaches that information is recorded on a physical document, i.e. paper, and digital data is stored on a microchip that is an electronic copy of the information recorded on the physical document).

Referring to claim 12, Ostrover teaches wherein the metadata comprises processing information, version information, user comments, copy information, transformation information, distribution information or index information (see column 4 lines 43-64, reference states that the data may be in a standard file format in which the examples listed inherently have metadata).

Referring to claim 13, Ostrover teaches wherein the computer is attached to the physical document by an adhesive (see column 5 lines 2-9).

Referring to claim 15, Ostrover teaches wherein the activity is selected from the group consisting of copying, providing comments, scanning, referencing an earlier version of the information (see columns 5 and 6, reference teaches a device which reads/writes to the microchip can be one of a printer, photocopy machine or a scanner,

a photocopy or printer can be used to record information on the physical document and the digital representation of which is stored in the microchip).

Referring to claim 16, Ostrover teaches wherein the metadata comprises at least one of an electronic copy of the information recorded on the physical document, comments by readers of the document, state changes and edits made since the document was printed, processing information, version information, copy information, transformation information, distribution information, index information, and other miscellaneous information (see column 3 lines 60-67 and column 4 lines 1-10 and 43-64).

Referring to claim 17, Ostrover teaches wherein the miscellaneous information comprises at least one of a document summary and key words (see column 6 lines 16-19, reference shows at least a portion of the content of the electronic copy of the physical document is stored in the memory device of the microchip which is equivalent to a document summary).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 8, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ostrover as applied to claims 1 and 7 above, and further in view of U.S. Patent No. 6533171 to Porter.

Ostrover does not disclose expressly wherein the computer comprises an iButton.

Porter discloses a similar system that makes use of an iButton (see column 2 lines 21-25, column 4 lines 35-48, and column 5 lines 1-7).

Ostrover & Porter are combinable because they are from the same field of endeavor, electronic data copies of physically printed documents.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to replace the microchip of Ostrover with the iButton of Porter.

The suggestion/motivation for doing so would have been to provide a more efficient way to store electronic data corresponding to a copy of a physical document. Porter teaches a system in which an iButton or smart card is used to store information that would normally appear on a business card (which is analogous to the computer in the claimed invention). The iButton or smart card can then be used in conjunction with a reader to send the stored information via e-mail to another participant. With Porter's system an individual no longer is required to carry a sufficient number of business cards or have to worry about how to carry and store them on his person. Also, more information can be stored in the iButton or smart card than on a tradition business card and the iButton or smart card can change and edit information that would normally force the individual to waste and/or reprint traditional business cards (see column 1).

Therefore, it would have been obvious to combine Porter with Ostrover to obtain the invention as specified in claims 5, 8, and 19.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ostrover as applied to claim 1 above, and further in view of U.S. Patent No. 5459307 to Klotz, Jr.

Ostrover does not disclose expressly wherein the computer has a machine readable label.

Klotz discloses a machine readable label (see column 3 lines 54-66 and column 5 lines 1-7 and 20-33, reference teaches a machine readable file storage sheet flag which informs the system that a machine readable sheet containing digitally encoded files is going to be read).

Ostrover & Klotz are combinable because they are from a similar problem solving area, notifying system about current document by way of a machine readable label.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the machine readable label of Klotz with the microchip of Ostrover.

The suggestion/motivation for doing so would have been the ability to notify the system about the current document that is about to be read. Klotz teaches the significance of the label is to inform the system that a file storage sheet follows and in turn the system knows where to scan the page for file attribute information. By implementing this advantage into the current invention allows a "modified" (as stated by applicants) printer, photocopier, or fax machine to know when the system is going to process a document that has an attached computer and enable read/write capabilities.

Therefore, it would have been obvious to combine Klotz with Ostrover to obtain the invention as specified in claim 6.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ostrover as applied to claim 1 above, and further in view of U.S. Patent No. 6477243 to Choksi et al.

Ostrover does not disclose expressly storing a URL for a digital version of the information recorded on the physical document.

Choksi discloses storing a URL for a digital version of the information recorded on the physical document (see column 3 lines 55-64, column 8 lines 49-67, and Fig. 5, reference teaches a system in which upon receiving a facsimile message a confirmation message is sent to the user notifying the user of the facsimile message and the URL where the message is located).

Ostrover & Choksi are combinable because they are from the same field of endeavor, electronic storage of a physical document.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the larger storage space provided by a URL of Choksi with the idea of storing an electronic copy of a physical document of Ostrover.

The suggestion/motivation for doing so would have been storing electronic data corresponding to a physical document by using a URL because of the larger amount of storage space available on a network environment. Choksi points out the benefits of being able to transmit larger files by way of a message containing a URL which points to the location of a document rather than sending the file as an attachment in a e-mail

message and risking the file exceeding a certain size limit and thus being stripped off the e-mail or being unable to send the attachment (see column 1).

Therefore, it would have been obvious to combine Choksi with Ostrover to obtain the invention as specified in claim 18.

Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ostrover as applied to claims 1 and 10 above, and further in view of U.S. Patent No. 5417508 to Friedman.

Ostrover does not disclose expressly wherein the computer is attached to the physical document by a spiral binding.

Friedman discloses attaching physical documents with a spiral binding (see Figs. 1-5, column 2 lines 58-67, and column 3 lines 1-45).

Ostrover & Friedman are combinable because they are from a similar problem solving area, attachment of multiple documents.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the attachment of documents using a spiral binding of Friedman with the attachment of documents and microchips of Ostrover.

The suggestion/motivation for doing so would have been to physically attach the microchip to the physical document.

Therefore, it would have been obvious to combine Friedman with Ostrover to obtain the invention as specified in claims 4 and 14.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ostrover. Ostrover fails to explicitly disclose wherein the metadata comprises text, or

Art Unit: 2622

portions thereof, of the information recorded on the document which has been translated into another language. However, Ostrover does state that the digital data can be in a number of different formats or languages and it is known in the art that metadata is data about data and refers to things such as origin, size, and formatting, and it is also known in the art that files or documents are changed to different formats on a regular basis for a multitude of reasons. Therefore it would have been obvious to a person of ordinary skill in the art at the time of the invention that metadata stores text, or a portion thereof, of the information recorded on the document which has been translated into another language.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (703) 305-1900. The examiner can normally be reached M-F 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached at (703) 305-4712. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

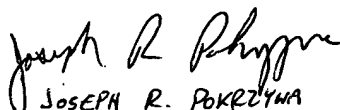
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Art Unit: 2622

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Mark R. Milia
Examiner
Art Unit 2622

MRM


JOSEPH R. POKRZYWA
EXAMINER
AU 2622